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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,533	01/27/1999	ROBERT MARSHALL	ATS016USQ	7419

7590

10/22/2003

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EXAMINER

PHAM, BRENDA H

ART UNIT	PAPER NUMBER
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2664

14

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/237,533

Applicant(s)

MARSHALL ET AL

Examiner

Brenda Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 24 and 25 is/are allowed.
- 6) ☐ Claim(s) 1,2,5-7,9-10,21-22 is/are rejected.
- 7) ☐ Claim(s) 3, 4, 8, 11, 12, 13, 23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This correspondence is in response to the applicant's response filed 9/10/2002.

Claims 1-13 and 21-25 are currently pending.

2. The indicated allowability of claims 1-13 and 21-25 is withdrawn in view of the newly discovered reference(s) to Jelen et al (US 6,119,935) and Jones et al (US 5,978,013). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5-7, 10, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jelen et al** (US 6,119,935), hereinafter refer to as Jelen, in view of **Jones et al** (US 5,978,013), hereinafter refer to as Jones.

-Regarding claims 1, 5, 10, 21, **Jelen** discloses a system for distributing and printing packets of information to individuals at selected retail locations upon request by said individuals (referring to figure 1, 5), said system including means for creating said packets of information in a digital format; a wireless network for transmitting said packets of information to said retail locations, each of said appliance being adapted to: receive said transmitted packets of information from said wireless network; process and

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store selected packets of information from said wireless network; process and store selected packets of information from all those received; convert said selected packets of information into a printable format for distribution to said individual; receive and process a request to print said packets of information by said individual; automatically print said selected packets in response to said request (column 4, lines 1-40, column 7, lines 14-40).

Jelen does not teach prevent misuse and unauthorized copying of said packets of information. Jones, in the same field of endeavors, teaches this limitation, in according to the abstract, lines 19-23. **Jones** teaches a printer generates a coupon bearing the coupon information. The coupon may have an anti-counterfeiting strip. The subscriber unit may keep track of the coupons printed and prevent the user from printing those coupons again.

For this reason, it would have been obvious to those having ordinary skill in the art at the time of the invention was made to implement the prevent misuse and unauthorized copying of said packet of information in Jelen.

-Regarding claims 2, 6-7, 22, **Jelen** teaches wherein said packets of information are redeemable retail coupons (see abstract, lines 9-10).

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Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 2, 5-7, 9, 10, 21-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,229,621 in view of Jones et al. (US 5,978,013).

Claims 1, 2, 5, 6, 7, 9, 10, 21-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 10 of U.S. Patent No. 6,229,621. Although the U.S. Patent No. 6,229,621 does not recited the step of prevent misuse and unauthorized copying of said packets of information, this claim limitation is well known and is taught by Jones et al (U.S. 5,978,013), in according to the abstract, lines 19-23).

Jones teaches a printer generates a coupon bearing the coupon information. The coupon may have an anti-counterfeiting strip. The subscriber unit may keep track of the coupons printed and prevent the user from printing those coupons again.

Therefore, it would have been obvious to those having ordinary skill in the art at the time of the invention was made to implement the anti-counterfeiting method in the U.S. Patent No. 6,229,621 to prevent misuses and unauthorized copying of coupons.

Allowable Subject Matter

7. Claims 24 and 25 allowed.

8. Claims 3, 4, 8, 11-13, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art made of record does not teach each of said printer appliance further includes a sensor adapted to detect whether said printed packet has been removed from said appliance.

The prior art made of record further fails to teach wherein said means for identifying includes a database manager having a directory of all printer appliances and means for identifying those printer appliances to which each of said packets are intended to be distributed.

The prior art further fails to teach wherein said printer appliance further includes a motion detector to detect the presence of an individual of an individual in the immediate proximity of said appliance and means to display a stimulus upon the detection of the presence of said individual.

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Conclusion

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Fax to:

(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington VA Sixth Floor (Receptionist)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (703) 308-0148. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Brenda Pham
October 15, 2003


WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600